

## **REMARKS**

### **INTRODUCTION**

In accordance with the foregoing, claims the claims have not been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1 through 11 are pending and under consideration. Reconsideration is respectfully requested.

### **ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116**

Applicants request entry of this Rule 116 Response and Request for Reconsideration because the Fleming reference applied to the claims is newly cited in the final Office Action, and Applicants should be provided the opportunity to present patentability arguments and amendments in view thereof.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### **REJECTIONS UNDER 35 U.S.C. §103(a)**

In the Office Action at pages 3 to 7, numbered item 5, claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,873,080 to Coden, et al. in view of U.S. Patent No. 6,230,204 to Fleming, III. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claim 1 includes "an outputting unit which outputs, when a piece of search target information is specified, the personal information on each user by whom the piece of search target information is searched based on the pieces of information stored in the information storage unit." Applicants respectfully submit that Coden, et al.

and Fleming, III, taken alone or in combination, fail to teach or suggest such a feature. Additionally, in the Office Action at page 4, the Examiner acknowledges that Coden, et al. fails to teach or suggest the storage of personal information with respect to each of a plurality of users and information indicating that the pieces of search target information are searched by the user, nor an outputting unit which outputs the personal information on each user by whom the piece of search target information is searched.

The Examiner cites Figures 9-10 of Fleming III in support of the position that Fleming III teaches an outputting unit as recited above. Figure 9 of Fleming III, as explained at col. 11, lines 30 to 50, is merely an illustration of the storage of demographic information corresponding to users selected to be part of a sample group. Figure 10 of Fleming III "is a diagram illustrating usage information for resources that are accessed, and an estimation of the total resource usage by all users of the resources." Fleming III, col. 12, lines 29-31. Thus, Applicants respectfully submit that Fleming III fails to teach or suggest any outputting unit and, more specifically, an outputting unit that outputs the person information of each user who searches for a piece of search target information, when that piece of search target information is specified. For at least this reason, Applicants submit that claim 1 patentably distinguishes over the prior art and is in condition for allowance.

Further, Applicants respectfully submit that Fleming III teaches away from the output of personal information of specific users. Fleming III teaches that, as an initial step, "[t]he RUR system uses the demographic information to select a group of users to be a representative sample of all computer users with access to the computer resources." Fleming III, col. 3, lines 55-58. As Fleming III seeks to estimate the total usage of resources by all users, the only data of interest for display or outputting is extrapolated data. Further, Fleming III teaches that "monitoring programs record usage of resource by the sample users, and periodically transfer the recorded information to a central analyzing facility." Fleming III, col. 3, lines 63-65. Thus, according to the teachings of Fleming III, the personal information on a user who searches for a piece of search target information cannot be outputted until the recorded information is transferred to a central facility and analyzed. For at least these reasons and those set forth above, Applicants respectfully submit that claim 1 patentably distinguishes over the prior art and is in condition for allowance.

As independent claims 2, 3 and 6-11 include similar outputting units, Applicants

respectfully submit that independent claims 2, 3, and 6-11, and claims 4 and 5, which depend from claim 3, patentably distinguish over the prior art for similar reasons as claim 1 and therefore are in condition for allowance.

## CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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